

The Examiner asserted that the application contains patentably distinct inventions as follows:

- I Claims 1-40 and 93-101, drawn to fuel cells comprising sealable features or a cartridge, classified in class 429, subclass 35;
- II Claims 41-62, drawn to a cartridge for refreshing the fuel cell, classified in class 220, subclass 500 or 507;
- III Claims 63-73, drawn to a packaged combination of plurality of cartridges, classified in class 220, subclass 23.83;
- IV Claims 74-82, drawn to a method of supplying electrical energy to a device classified in class 429, subclass 13;
- V Claims 83-90, drawn to the combination of a device and a fuel cell, classified in class 429, subclass 12;
- VI Claims 91-92, drawn to the combination of a device and a fuel cell, classified in class 429, subclass 12;
- VII Claims 102-113, drawn to a fluid replacement system for replacing a spend liquid, classified in class 137, subclass 583, or 561 R or 560 or 255 or 266; and
- VIII Claims 114-117, drawn to a liquid replacement method, classified in class 137, subclass 2 or 15.18.

In support of this restriction requirement, the Examiner asserted that the inventions were related as combination/subcombination, process and apparatus for its practice, and unrelated invention.

As regards the assertions of combination and subcombination, Applicant submits that the instant restriction is improper and not compliant with MPEP 806.05(d) which provides:

To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, **both two-way distinctness and reasons for insisting on restriction are necessary**. Each subcombination is distinct from the combination as claimed if:

(A) the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in another materially different combination. See MPEP § 806.05(c). Furthermore, **restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search.** (Emphasis Added)

First, the Examiner has not established, or even asserted, two-way distinctiveness. As the Examiner well knows, two-way distinctiveness requires the following: it must be shown first that one group recites a feature that is not recited in the other group, and second that the other group recites a feature that is not in the one group. This has clearly not been demonstrated by the Examiner. Nor can it be when all of the groups recite numerous common or similar features.

Second, Applicant notes that MPEP 806.05(d) specifically states “restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search” (emphasis added). While the Examiner has mentioned the burden requirement, the Examiner has omitted any detailed discussion of the required burden. As set forth in M.P.E.P. § 803, “an appropriate explanation” must be advanced by the Examiner as to the existence of a “serious burden” if the restriction requirement were not required.

As regards the unrelated invention basis, the Examiner has failed to appreciate that the claim groups all relate to a fuel cells or fuel cell components and are clearly related.

Finally, as regards all of the bases for the restriction requirement, Applicant emphasizes that while the Examiner has alleged possible distinctions between the identified groups of invention, the Examiner has not shown that a concurrent examination of these groups would present a “serious burden” on the Examiner. In fact, the Examiner has noted that the many of the groups would be

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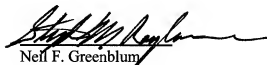
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classified in the same class, i.e., class 429. Nor has the Examiner properly and convincingly set forth an appropriate statement indicating that the search areas required to examine the invention of each group would not overlap into the search areas for examining the invention of other of the groups, and vice versa.

Applicant respectfully submits that the search for the combination of features recited in the claims of the above-noted groups, if not totally co-extensive, would appear to have a very substantial degree of overlap. Because the search for each group of invention is likely to be substantially the same, Applicant submits that no undue or serious burden would be presented in concurrently examining Groups I-VIII. For all of the above reasons, the Examiner's restriction requirement is believed to be improper.

Should the Examiner have any questions or comments, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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